

Customer No. 24498
Internal Docket No. PA040012
Office Action Date: 04/28/2009

Remarks / Discussion of Issues

In the non-final Office action dated April 28, 2009, it is noted that claims 1-9 are pending and claims 1-9 stand rejected. Claims 1, 6 and 9 are independent claims. Claim 10 is newly added. Support for claim 10 can be found at least at paragraph [0030] of the published specification 2007/0201828. No new subject matter is added.

By this response, claims 1, 2, 4, 6, and 9 have been amended to clarify certain aspects of the claimed invention and also for non-statutory reasons. No new subject matter is added.

Applicants request the Examiner to confirm that the specification heading amendments submitted by preliminary amendment at the time of filing this application have been entered into the record since these amendments do not appear in the published specification 2007/0201828.

Drawings

The Office action alleges that new drawings are required. By this response, Applicants submit replacement drawings. Submitted with this response are replacement sheets '1/2' (Figures 1, 2, and 3) and '2/2' (Figures 4 and 5). No new subject matter is added.

Claim Objections

The Office action objects to claims 1 and 4-6 because of alleged informalities.

As per the Examiner's suggestions, Applicants address these objections with regard to the informalities. For example, claims 1 and 6 are amended to remove the phrase "an MPEG-like" from the claims. Claim 4 is amended to "a previous inter-coded picture." Claim 1 is amended to "a picture information representative for a new recording," thereby providing sufficient antecedent basis for claim 5. No new subject matter is added. As such, Applicants respectfully request the withdrawal of the claim objections.

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Rejections under 35 U.S.C. §101

Claim 9 stands rejected under 35 U.S.C. § 101 because the claim does not define a computer-readable medium or computer-readable memory.

As per the Examiner's suggestions, Applicants address this rejection by amending claim 9 to define a computer-readable medium. Support for this amendment is found at least, as one example, at Fig. 5 and paragraph [0030] of the published specification. Fig. 5 shows, for example, an optical disk D1, which is known to be a computer-readable medium. Thus, Applicants submit that claim 9 is directed to statutory subject matter and respectfully request the withdrawal of this rejection under 35 U.S.C. § 101.

Cited Art

The art cited and applied in the present Office action includes: U.S. Patent 6,078,328 to Schumann et al. (hereinafter referenced as "Shumann"), and U.S. Patent 7,046,260 to Frimout et al. ("Frimout").

Rejections under 35 U.S.C. §102

Claims 1, 4, and 9 stand rejected under 35 U.S.C. §102(b) as allegedly being anticipated by Schumann. Claims 6-8 stand rejected under 35 U.S.C. §102(e) as allegedly being anticipated by Frimout. Applicants respectfully traverse these rejections.

In order for a reference to anticipate a claim, the MPEP 2131 requires the reference to teach every element of the claim. According to MPEP 2131, "[t]he identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

It is respectfully submitted that the Office action failed to establish a *prima facie* case of anticipation.

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Applicants' claim 1 recites, in part,

generating an inter-coded picture having no change information for predefined blocks, and having change information for selected blocks containing a picture information representative for a new recording on the video recording medium. (Emphasis added.)

The Office action alleges that Schumann at column 3, lines 16-25; column 4, lines 25-28; column 7, lines 4-7; and figure 3 discloses these features. However, Applicants respectfully submit that Shumann does not disclose generating an inter-coded picture having no change information for predefined blocks, and having change information for selected blocks containing a picture information representative for a new recording on the video recording medium, as required by claim 1.

Schumann apparently discloses a method for compressing MPEG graphics elements by either modifying the I-frame or overlying the I-frame with one or more of the P-frames. (Abstract). Schumann apparently discloses that graphics elements are combined with the video image by replacement (column 3, lines 3-4), or overlaid onto MPEG video (column 3, lines 16-17). In other words, Shumann appears to disclose using pre-compressed building blocks, whereby a plurality of graphics elements are stored, and then one or more of the graphics elements is selected from among the plurality of graphics elements. The elements are then combined with an original video image to produce a combined original video and selected graphics elements coded into a compressed video signal format. (Column 2, lines 50-65). This disclosure is completely different from the Applicants' claimed invention.

Schumann does not disclose generating an inter-coded picture having change information for selected blocks containing a picture information representative for a new recording. As disclosed at paragraphs [0005] and [0012] of Applicants' published specification, an example of the picture information representative for a new recording includes thumbnails of recordings (e.g. downsized versions of video), which are generated using the output of a representative picture memory. Hence, Schumann does not generate an inter-coded picture having change information containing a picture information representative for a new recording. In Schumann the changed areas within the P-frame are merely encoded using intra-coded, pre-compressed

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macroblocks. (Column 3, lines 21-25). This is completely different from generating an inter-coded picture having change information containing a picture information representative for a new recording. Nowhere does Schumann disclose the feature of generating an inter-coded picture having no change information for predefined blocks, and having change information for selected blocks containing a picture information representative for a new recording on the video recording medium, as set forth in Applicants' claim 1.

Furthermore, Applicants' claim 1 recites, in part,

storing both the intra-coded picture and the inter-coded picture
as menu information on the video recording medium.

As pointed out above, Schumann does not disclose the inter-coded picture of Applicants' claim 1, wherein the inter-coded picture has change information for selected blocks containing a picture information representative for a new recording on the video recording medium. Therefore, Schumann does not store such inter-coded picture as menu information on the video recording medium. Thus, Schumann does not disclose the feature of storing both the intra-coded picture and the inter-coded picture as menu information on the video recording medium, as required by Applicants' claim 1.

Applicants respectfully submit that the rejection of claims 1 under 35 U.S.C. §102(b) has been traversed as per MPEP 2131.

Independent claim 9, although different from claim 1, includes several similar distinguishing features as discussed above with respect to claim 1. For example, claim 9 is directed to a computer readable medium. Claim 9 includes in part: wherein the menu comprises a predefined intra-coded picture and at least one inter-coded picture having difference information only for selected areas, the difference information being related to picture information representative for a new recording.

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The Office action uses substantially the same arguments as set forth with regard to claim 1, alleging that independent claim 9 is anticipated by Schumann. Applicants essentially repeat the above arguments for claim 1 relating to picture information representative for a new recording and apply them to independent claim 9. As such, Applicants respectfully submit that claim 9 is not anticipated by Schumann and requests the withdrawal of the rejection of independent claim 9.

Dependent claim 4 depends upon and incorporates by reference all the features of allowable claim 1. Furthermore, dependent claim 4 includes additional distinguishing features. Applicants essentially repeat the above arguments from claim 1 and apply them to dependent claim 4. Thus, Applicants respectfully submit that dependent claim 4 is allowable at least by virtue of its dependency on claim 1.

Applicants respectfully submit that the rejection of claims 1, 4, and 9 under 35 U.S.C. §102(b) has been traversed.

Applicants' claim 6 recites, in part,

a recording unit equipped to record the predefined intra-coded picture and the inter-coded picture onto the recording medium.
(Emphasis added.)

The Office action alleges that Frimout at column 3, lines 21-22 discloses a disk drive unit. However, Applicants respectfully submit that Frimout does not disclose a recording unit equipped to record the predefined intra-coded picture and the inter-coded picture onto the recording medium, as required by claim 6.

Frimout appears to disclose a method for generating a menu whereby the entire menu picture assembly operation is performed in the compressed picture domain such that no pictures need to be decoded. (Abstract). Frimout at column 7, lines 7-9 and at claim 13(c) apparently suggests that the assembled or generated menu is recorded onto an optical disc.

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However, Frimout does not disclose a recording unit equipped to record the predefined intra-coded picture and the inter-coded picture onto the recording medium. Instead, Frimout appears to teach away from recording the predefined intra-coded picture and the inter-coded picture onto the recording medium. As mentioned earlier, the entire menu operation of Frimout is performed in the compressed picture domain whereby no pictures are decoded. Frimout at column 1, lines 41-51 apparently suggests that the repeated decoding of the background picture and the key frames are a drawback for generating a menu, therein apparently suggesting that the intra-coded and inter-coded pictures are not recorded. This teaching is reflected in the Abstract, where Frimout recites, "[t]hereby, the normal encoding-decoding pipeline of the recording device is not required for menu generation, such that hardware and software requirements can be reduced."

Further, Frimout is directed to the assembly of a menu picture, and focuses in large part on the scaling and compressing of a key frame picture. This is a different focus from Applicant's specification. It is not surprising therefore, that Frimout does not appear to disclose or suggest the further feature of "generating an inter-coded picture using an output of the intra-coded picture memory as basis and an output of the representative picture memory as changes to be recorded", as is also recited in claim 6.

In summary, nowhere does Frimout disclose the feature of a recording unit equipped to record the predefined intra-coded picture and the inter-coded picture onto the recording medium as set forth in Applicants' claim 6. Additionally, Frimout does not appear to disclose the further feature of claim 6 of "generating an inter-coded picture using an output of the intra-coded picture memory as basis and an output of the representative picture memory as changes to be recorded". Therefore, Applicants respectfully submit that the rejection of claim 6 under 35 U.S.C. §102(e) has been traversed as per MPEP 2131 and requests the withdrawal of the rejection to claim 6.

Dependent claims 7 and 8 depend upon and incorporate by reference all the features of allowable claim 6. Furthermore, dependent claims 7 and 8 include additional distinguishing features. Applicants essentially repeat the above arguments from claim 6 and apply them to dependent claims 7 and 8. Thus, Applicants

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respectfully submit that dependent claims 7 and 8 are allowable at least by virtue of its dependency on allowable claim 6.

Applicants respectfully submit that the rejection of claims 6-8 under 35 U.S.C. §102(e) has been traversed and respectfully requests the withdrawal of the rejection to these claims.

Rejections under 35 U.S.C. §103

Claims 2, 3, and 5 stand rejected as allegedly being unpatentable over Schumann in view of Frimout. Applicants respectfully traverse these rejections.

Dependent claims 2, 3, and 5 depend ultimately upon allowable claim 1. Each dependent claim incorporates by reference all of the respective features of claim 1, from which they depend, in addition to containing further distinguishing patentable features.

Schumann and Frimout, separately or in combination, do not cure the deficiencies as noted as applied to claim 1. Therefore, for at least the same reasons discussed above with respect to claim 1, the combination of Schumann and Frimout does not teach or even suggest all the features of claims 2, 3, and 5.

Hence, withdrawal of the rejection to claims 2, 3, and 5 under 35 U.S.C. § 103(a) and early allowance of the claims is respectfully requested.

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Conclusion

Having fully addressed the Examiner's rejections it is believed that, in view of the preceding amendments and remarks, this application stands in condition for allowance. Accordingly then, reconsideration and allowance are respectfully solicited. If, however, the Examiner is of the opinion that such action cannot be taken, the Examiner is invited to contact the Applicants' attorney at (609) 734-6817, so that a mutually convenient date and time for a telephonic interview may be scheduled.

Please charge any required additional fee or credit any overpayment to Deposit Account No. 07-0832.

Respectfully submitted,
Cheng Tao, et al.

By:



Brian J. Dorn
Attorney for Applicants
Registration No. 43,594

THOMSON Licensing LLC
PO Box 5312
Princeton, NJ 08543-5312

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